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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/273,102 03/19/99 GLASSMAN

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EXAMINER

TM02/0409

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ART UNIT

PAPER NUMBER

2164

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/273,102

Applicant(s)
Glassman et al

Examiner
Daniel F Iten

Group Art Unit
2164



☒ Responsive to communication(s) filed on Mar 19, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 1-21 is/are pending in the application

Of the above, claim(s) _____ is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-21 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 4

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

DETAILED ACTION

Claim Rejections - 35 USC § 102

1
2
3 1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form
4 the basis for the rejections under this section made in this Office action:

5 A person shall be entitled to a patent unless --

6
7 (e) the invention was described in a patent granted on an application for patent by another filed in the United
8 States before the invention thereof by the applicant for patent, or on an international application by another who
9 has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371 of this title before the invention
10 thereof by the applicant for patent.

11 2. Claims 11-21 are rejected under 35 U.S.C. 102(e) as being anticipated by Hiroya et al
12 (EP 0848 343 A2).

13 **Regarding claims 11-14:** Hiroya et al discloses, as in claim 11, a method of providing a
14 refund in an electronic commerce system, comprising the steps of: receiving, by a second party
15 from a first party, electronic currency for which the first party seeks a refund, wherein the
16 electronic currency includes a first value derived from information identifying the first party;
17 receiving, by the second party from the first party, the information identifying the first party and
18 instructions for deriving the first value from the identifying information; using, by the second
19 party, the instructions for deriving the first value from the identifying information to derive a
20 second value from the provided information identifying the first party; comparing, by the second

1 party, the second value with the first value; and enabling, by the second party, a refund for the
2 electronic currency if the first value matches the second value (see Abstract; and col. 11, line 9 to
3 col. 15, line 8);

4 as in claim 12, wherein the step of receiving the information identifying the first party and
5 instructions for deriving the first value from the identifying information comprises the steps of
6 receiving, by the second party, information uniquely identifying the first party
7 receiving, by second party, at least one nonce with which the information uniquely identifying
8 the first party is hashed to produce the second value (see Abstract; and col. 1, lines 33-35);

9 as in claim 13, wherein the information identifying the first 2 party includes a
10 predetermined value (*hashed value*, col. 1, lines 35-47);

11 as in claim 14, wherein the predetermined value is a text string (*digital signature*, col. 1,
12 lines 33-35).

13
14 **Regarding claims 15 and 16:** Hiroya et al further discloses, as in claim 15, further
15 comprising the steps of: issuing, by the second party to the first party, a refund coupon entitling
16 the first party to a refund for the electronic currency (see col. 12, line 38 to col. 13, line 34).

17 as in claim 16, further comprising the steps of receiving, by a third party from the first
18 party, the refund coupon and the electronic currency for which the first party seeks a refund;

19 receiving, by the third party from the first party, an identification value for electronic
20 currency previously issued by the third party; and issuing, by the third party to the first party,

1 electronic currency having the provided identification value (see col. 13, line 41 to col. 14 line
2 48).

3
4 **Regarding claims 17-21:** Hiroya et al further discloses, as in claim 17, a computer
5 readable medium 83 (receipt) having computer instructions encoded thereon for directing a
6 computer system to provide a refund in an electronic commerce system, the computer
7 instructions comprising instructions for (col. 11, lines 11-20):

8 receiving a request to refund electronic currency, the electronic currency including a value
9 identifying the party to whom the currency was issued (see col. 12, lines 33-49);

10 receiving identifying information identifying the party seeking the refund (see col. 12,
11 lines 33-49);

12 verifying that the received identifying information matches the value in the electronic
13 currency identifying the party to whom the electronic currency was issued (see col. 12, lines 6-
14 14); and

15 responsive to a positive verification, entitling the party to whom the electronic currency
16 was issued to a refund for the electronic currency (see col. 11, 46-55; col. 12, lines 38-49);

17 as in claim 18, the computer readable medium further comprising instructions for:
18 receiving values to be utilized for transforming the information identifying the party seeking the
19 refund into the value identifying the party to whom the currency was issued (col. 14, lines 37-48)

20 ;

1 as in claim 19, the computer readable medium wherein the instructions for receiving
2 values comprise instructions for: receiving one or more nonces with which the information
3 identifying the party seeking the refund is hashed to produce the value identifying the party to
4 whom the currency was issued (col. 11, lines 21-29);

5 as in claim 20, the computer readable medium wherein the instructions for entitling the
6 party to whom the currency was issued to a refund for the electronic currency comprise
7 instructions for:

8 issuing a refund coupon to the party seeking the refund;

9 wherein the party seeking the refund can use the refund coupon to refund the electronic
10 currency at a party who issued the electronic currency (see col. 13, lines 1-16);

11 as in claim 21, the computer readable medium further comprising instructions for:

12 receiving electronic currency containing a first value identifying the party to whom the
13 currency was issued;

14 hashing the first value identifying the party to whom the currency was issued
15 with a nonce to form a second value identifying the party to whom the currency was issued; and

16 issuing electronic currency incorporating the second value identifying the
17 party to whom the currency was issued; wherein the received request to refund electronic
18 currency comprises a request to refund the electronic currency incorporating the second value
19 (see col. 14, line 37 to col. 15, line 8).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim rejected under 35 U.S.C. 103(a) as being unpatentable over Manasse (US 5,802,497) in view of Hiroya et al (EP 0 848 343 A2).

Regarding claims 1 and 2: Manasse discloses, as in claim 1, a system 100 comprising: a first system 110 (broker system) for issuing scrip, the scrip including a value identifying a recipient of the scrip (see col. 2, lines 56-65; and col. 3, lines 34-44), a second system 130 (consumer system) in communication with the first system 110, and as in claim 2, a third system in communication with the first and second systems for receiving the scrip including the value identifying the recipient of the scrip of the first system.

Manasse fails to disclose, as in claim 1, issuing a refund for the scrip issued by the first system, and wherein the second system is adapted to use the value identifying the recipient of the scrip to verify the recipient of the refund, and as in claim 2, for receiving the refund for the scrip from the second system.

1 Hiroya discloses a shopping system which discloses issuing a refund of electronic money
2 from at least two processing systems from which there is verification of the refund (see Abstract).
3 Electronic refunds, and verification of transactions are conventional features utilized in the art,
4 particularly in electronic wallets or credit cards, where electronic funds may be re-accredited/re-
5 issued to an account because of a discount, rebate, coupon, or unsatisfactory purchase of a good
6 or service. Therefore, it would have been obvious for an artisan of ordinary skill in the art at the
7 time of the invention of Manasse to integrate the refund of electronic money feature found in
8 Hiroya because an artisan at the time of the invention of Manasse would have recognized the
9 refund feature would provide an added convenience and satisfaction to the customer by allowing
10 automatic repayment of electronic currency without having to travel distances, wait in lines, or
11 provide addition identification. Thus such a modification would have constituted an obvious
12 expedient to one of ordinary skill in the art.

13
14 **Regarding claims 3-7:** Manasse in view of Hiroya et al further disclose, as in claim 3,
15 the third system is adapted to store one or more nonces utilized to create the value in the scrip
16 identifying the recipient of the scrip (see Manasse, fig. 4, col. 4, lines 49-57);

17 as in claim 4, wherein the first system is adapted to receive information identify the
18 recipient of the scrip prior to issuing the scrip to the recipient (see definition of a *scrip*; also
19 Manasse, col. 3, lines 34-44);

1 as in claim 5, wherein the first system is further adapted to hash the received information
2 identifying the recipient with a nonce and store the hash in the issued scrip;

3 as in claim 6, wherein the received information identifying the recipient is a hash of
4 identifying information with a second nonce; and

5 as in claim 7, the second system is further adapted to receive from the recipient of the
6 scrip identity information and at least one nonce for deriving the value recipient of the scrip (see
7 Hiroya, col. 1, line 28 to col. 2, line 4).

8
9
10 **Regarding claims 8-10:** Manasse discloses, as in claim 8, a scrip for use in an
11 electronic commerce system, the scrip comprising: a first field containing a first value from
12 which a broker and a vendor can verify that a consumer possesses the right to exchange the scrip
13 420 (*verification code*, see col. 5, lines 6-30); and

14 as in claim 10, the scrip wherein a third field containing a third value indicating the latest
15 date on which the scrip can be refunded (*expiration date* col. 4, lines 65 to col 5, line 5).

16 Manasse fails to explicitly disclose a second field containing a second value derived from
17 information identifying the consumer, wherein the broker and vendor can use the second value to
18 verify the identity of the consumer; and as in claim 9, the scrip wherein the second value is
19 derived from the information identifying the consumer hashed with at least one nonce.

1 Hiroya et al disclose a field derived from verifying the identity of the consumer (see
2 Hiroya et al, col. 7, lines 44-50). Certifying and authentication of electronic data is conventional
3 within the art to protect the reception and transmission of data between two parties. Therefore, it
4 would have been obvious for an artisan of ordinary skill in the art at the time of the invention to
5 acquire a means of certification/ authentication/verification of a consumer to provide security in
6 the transmission/reception of sensitive data.

Conclusion

5. A list of cited references appears below not relied upon in this Office Action:

United States Patents:

Kravitz (US 6,029,150) discloses a payment and transactions in electronic commerce system

Nakano et al (US 5,987,438) discloses an electronic wallet system

Barber (US 5,930,777) discloses a method of charging for pay-per-access information over a network

Schwaim et al (US 5,339,361) discloses a system and method for authenticating transmission and receipt of electronic information

Ito et al (US 6,039,250) discloses an electronic money sending system

Nakamura et al (US 5,917,168) discloses a system and method for revaluation of stored tokens in IC cards

Shiobara et al (US 6,10,864) discloses a terminal device and terminal system.

Foreign Patents:

Hiroya (JP 10-171887) discloses a shopping system

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Daniel S. Felten** whose telephone number is (703) 305-0724. The examiner can normally be reached between the hours of 7:00AM to 5:30PM Monday-Thursday. Any inquiry of a general nature relating to the status of this application or its proceedings should

1 be directed to the Customer Service Office (703) 306-5631, or the examiner's supervisor

2 **Vincent Millin** whose telephone number is (703) 308-1065.

3
4 7. Response to this action should be mailed to:


5
6 Commissioner of Patents and Trademarks

7 Washington, D.C. 20231

8
9 for formal communications intended for entry, or (703) 305-0040, for informal or draft
10 communications, please label "Proposed" or "Draft".

11 Communications via Internet e-mail regarding this application, other than those under 35
12 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be
13 addressed to [*daniel.felten@uspto.gov*].

14 All Internet e-mail communications will be made of record in the application file. PTO
15 employees do not engage in Internet communications where there exists a possibility that
16 sensitive information could be identified or exchanged unless the record includes a properly
17 signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly
18 set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and
19 Trademark on February 25, 1997 at 1 195 OG 89.

20
21
22 
23 **Daniel S. Felten**
24 **April 03, 2001**


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